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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,507	02/13/2002	Marco Peters	Q68452	7621

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EXAMINER

VAUGHN JR, WILLIAM C

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/049,507

Applicant(s)

PETERS ET AL.

Examiner

William C. Vaughn, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Action is in regards to the Amendment and Response received on 22 November 2004.

Response to Arguments

2. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Specification

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) The Names Of The Parties To A Joint Research Agreement: See 37 CFR 1.71(g).
- (e) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.
- (f) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:

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- (1) **Field of the Invention:** A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) **Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98:** A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (g) **Brief Summary of the Invention:** See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (h) **Brief Description of the Several Views of the Drawing(s):** See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (i) **Detailed Description of the Invention:** See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (j) **Claim or Claims:** See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).

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- (k) **Abstract of the Disclosure**: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e). **No reference labels to the figures.**
- (l) **Sequence Listing**. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

It is requested the Applicant provide a proper Specification that includes each of these items. And a proper heading to each of these items

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding exemplary claim 1, the recitation states “a telecommunication system for receiving at least one control signal from a user via a terminal and comprising said terminal and a network ***for in response to said at least one control signal addressing a memory*** comprising . It is requested that Applicant provide more clear claim limitations. Since the limitations that are currently presented are unclear.

Claim Objections

5. Claim 1 objected to because of the following informalities: The recitation states “*at at least one memory*”. The examiner will interpret this state “at least one memory”. Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta et al. (Gupta), WO 99/60459 in view of Ebrahim, EP 0817444 A2.

8. Regarding **claim 1**, Gupta discloses the invention substantially as claimed. Gupta discloses a *telecommunication system for receiving at least one control signal from a user via a terminal* (Gupta teaches a client utilizing a browser provides to a DNS resolver a web server name [see Gupta, abstract, see page 6, lines 15-17, page 13, lines 3-17] *and comprising said terminal and a network for in response to said at least one control signal addressing a memory comprising information to be supplied to said terminal and stored at least one memory location defined by at least one address signal* (Gupta teaches that the DNS server responds, when appropriate, with data, a table of data, or a thin client applet to the client browser), [see Gupta, page 13, lines 13-27 and page 14, lines 1-19]; *said telecommunication system comprises a generator (DNS server) for generating at least one address signal in response to said at least*

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one control signal in a user-dependent way (Gupta teaches that primary DNS server handles requests from other resolvers such as request 207 as well as request from a client browser resolver), [see Gupta, Page 14, page 4-25 and page 15, lines 1-15]. However, Gupta does not explicitly disclose said memory providing different information to said user from different memory locations depending on the address signal generated.

9. In the same field of endeavor, Ebrahim discloses (e.g., a system for context-dependent name resolution). Ebrahim discloses said memory providing different information to said user from different memory locations depending on the address signal generated [see Ebrahim, Col. 6, lines 25-58, Col. 7, lines 1-40].

10. Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Ebrahim's teachings of a system for context-dependent name resolution with the teachings of Gupta, for the purpose of decreasing congestion [see Ebrahim, Col. 1, lines 50-59]. By this rationale **claim 1** is rejected.

11. Regarding **claim 2**, Gupta-Ebrahim discloses *said user-dependent way comprises at least one location dependency and/or at least one time-dependency* (Gupta teaches utilizing distance metric tables that are created by agents collecting network topology and load information), [see Gupta, page 16, lines 5-17 and Col. 17, lines 1-12]. By this rationale **claim 2** is rejected.

12. Regarding **claim 3**, Gupta-Ebrahim discloses *at least one part of said generator is located in said network* (Gupta teaches a local area network and the internet), [see Gupta, items 125 and 122]. By this rationale **claim 3** is rejected.

13. Regarding **claim 4**, Gupta-Ebrahim discloses *said at least one part of said generator performs said generating in dependence of a location signal to be generated via said network*

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[see Ebrahim, Col. 4, lines 10-59, Col. 5, line 1-59 and Col. 6, lines 1-57]. By this rationale **claim 4** is rejected.

14. Regarding **claim 5**, Gupta-Ebrahim discloses *at least one part of said generator is located in said terminal* [see rejection of claim 1, supra]. By this rationale **claim 5** is rejected.

15. Regarding **claim 6**, Gupta-Ebrahim discloses *ed in that said at least one part of said generator performs said generating in dependence of a further location signal to be generated via said terminal* [see Ebrahim, Col. 3, lines 1-14]. By this rationale **claim 6** is rejected.

16. Regarding **claim 7**, Gupta-Ebrahim discloses *a network* [see Gupta, items 122 and 125] *for use in a telecommunication system for receiving at least one control signal from a user via a terminal and comprising said terminal and said network for in response to said at least one control signal addressing a memory comprising information to be supplied to said terminal and stored at least one memory location defined by at least one address signal, said network comprises a generator for generating at least one address signal in response to said at least one control signal in a user-dependent way* [see rejection of claim 1, supra]. By this rationale **claim 7** is rejected.

17. Regarding **claim 8**, Gupta-Ebrahim discloses *a terminal* (Gupta teaches a client browser) *for use in a telecommunication system for receiving at least one control signal from a user via said terminal and comprising said terminal and a network for in response to said at least one control signal addressing a memory comprising information to be supplied to said terminal and stored at least one memory location defined by at least one address signal, said terminal comprises a generator for generating at least one address signal in response to said at least one*

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control signal in a user-dependent way [see rejection of claim 1, supra]. By this rationale **claim 8** is rejected.

18. Regarding **claim 9**, Gupta-Ebrahim discloses *a generator (DNS server) for use in a telecommunication system for receiving at least one control signal from a user via a terminal and comprising said terminal and a network for in response to said at least one control signal addressing a memory comprising information to be supplied to said terminal and stored at least one memory location defined by at least one address signal, in that said telecommunication system comprises said generator for generating at least one address signal in response to said at least one control signal in a user-dependent way* [see rejection of claim 1, supra]. By this rationale **claim 9** is rejected.

19. **Claim 10** list all the same elements of claims 1, 7-9, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claims 1, 7-9 applies equally as well to claim 10.

Response to Arguments

20. Applicant's arguments filed on 08 April 2003 have been carefully considered but they are not deemed fully persuasive. However, because there exists the likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address applicants' main points of contention. Applicant's arguments include:

- A. Applicant argues that there is no discussion in Gupta et al. of the concept of providing different capabilities to different terminals who enter the same URL from different locations.

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B. Applicant further states that “in contrast, the purpose of the present invention is to customize the information provided to the user, i.e., providing different information different users who enter the same URL or providing different information to a single user who enters the same URL from different locations”.

21. As to “Point A”, applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., same URL) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). However, it is the position of the examiner that in combination Gupta-Ebrahim do provide the teachings of a system that allows for a memory [see Ebrahim, items 100 and 160] that contains different information to a user from different memory locations depending on the address signal generated (Ebrahim teaches tables (memory) within the memory area that contain information that can be dependent upon location, type of service), [see Ebrahim, Col. 5, lines 43-57, Col. 6, lines 25-57, Col. 7, lines 1-57].

22. As to “Point B”, the response to Point A applies equally as well as to Point B.

23. Again, it is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art. As it is Applicant's right to continue to claim as broadly as possible their invention. It is also the Examiner's right to continue to interpret the claim language as broadly as possible. It is the Examiner's position that the detailed functionality that allows for Applicant's invention to overcome the prior art used in the rejection,

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fails to differentiate in detail how these features are unique (see Applicant's enabling portions of the specification, pages 4-17, i.e., generator conversion at different location and same URL or IP address). As it is extremely well known in the networking art as already shown by Gupta-Ebrahim and other prior arts of records disclosed, memory providing different information to said user from different memory locations depending on the address signal generated as well as other claimed features of Applicant's invention. Thus, it is clear that Applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claim invention.

24. Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response, and reiterates the need for the Applicant to more clearly and distinctly, define the claimed invention.

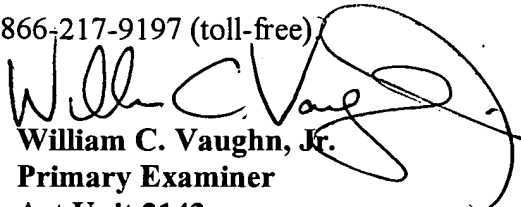
Conclusion

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Vaughn, Jr. whose telephone number is (571) 272-3922. The examiner can normally be reached on 8:00-6:00, 1st and 2nd Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


William C. Vaughn, Jr.
Primary Examiner
Art Unit 2143
17 May 2005

WCV